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10/622,825	07/21/2003	Pierre Garnier	235828US26CONT	3038
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
HUGHES, ALICIA R				
ART UNIT		PAPER NUMBER		
1614				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/622,825

Applicant(s)

GARNIER, PIERRE

Examiner

ALICIA R. HUGHES

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-944)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2 sheets.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 54-64 are pending and the subject of this Office Action.

Applicants' arguments, filed on 14 October 2008, have been fully considered and are deemed to be persuasive regarding the previous rejections. As such, the finality of the Office Action filed on 14 October 2008 is hereby withdrawn. Rejections and objections not reiterated from previous Office Actions are hereby withdrawn.

Upon reconsideration of the pending claims, as presented, the following rejections are applied. They constitute the complete set of rejections being applied to the instant application presently.

Claim Rejections – 35 U.S.C. §103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54-57 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,968,533 [hereinafter referred to as "Porter et al"] in view of U.S. Patent No. 6,174,536 [hereinafter referred to as "Crotty et al"] and in further view of U.S. Patent No. 4, 925,667 [hereinafter referred to as "Fellows et al"].

Applicant argues that Porter et al and Crotty et al do not disclose or suggest the kit of instant claims 54-57, because neither reference discloses a requirement for a plurality of

reference images, a transparent substrate, or a visualizing substrate (Applicants Arguments of October 14, 2008 at page 5, para. 3).

The teachings of Porter et al and Crotty et al from this Office's Action of 13 May 2008 are incorporated herein by reference in their entirety.

In assigning the claims their broadest reasonable interpretation, the Examiner has construed the teachings in Crotty et al, particularly the removal of keratotic plugs from the skin which utilizes a test device/strip that when contacted with a certain polymeric composition and a fluid, has adhesive properties, most notably a test strip that once wetted and applied to the skin, adheres to the skin and upon drying, can be pulled away concomitantly, pulling keratotic plugs with it (Col. 7, lines 1-16; Col. 8, lines 1-15), as meeting the limitation for a visualizing substrate. The result of removing the adhesive substrate is evidence in the form of quantifiable keratotic plugs and this process is a repeatable one, hence providing a plurality of images.

With regard to the limitation calling for a transparent substrate, Fellows et al disclose a cosmetic invention that can be used in many different applications (Col. 7, lines 4-5), and "[t]he cosmetic can be deposited onto colored or transparent substrates ..." (Col. 7, lines 3-7).

One of ordinary skill in the art would be motivated to combine the teachings of Porter et al with the teachings of Crotty et al., because the references teach overlapping subject matter, most notably, cosmetic or care products for the skin using adhesive test devices. More particularly, both inventions are directed to improving the condition of the skin by placing a penetrable composition on the skin that is affixed to an adhesive to yield an effacious result, and it is understood in the art that "[a] need has arisen for reliable and easily visible device[s] for skin

sampling for the collection of skin cells from the surface of the skin” (U.S. Patent No. 5,088,502, Col. 1, lines 33-35), and it is this common need that is discussed in both references.

One of ordinary skill in the art would be motivated to modify the teachings of Porter et al and Crotty et al with the teachings of Fellows et al, due to their overlapping subject matter, most notably improvement of cosmetic applications involving test strips.

When used together, in light of the foregoing, it would have been *prima facie* obvious to one of ordinary skill to create a test device to determine the efficacy of a skin care or cosmetic product to treat wrinkles and other signs of aging.

Claims 58-64 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,968,533 [hereinafter referred to as “Porter et al”] in view of Fellows et al in view of U.S. Patent No. 5,723,138 [hereinafter referred to as “Bae et al”] in view of French Patent Publication No. 2,063,743 30 October 1969 [hereinafter referred to as “Bouyer”], and in further view of U.S. Patent No. 5,935,596 [hereinafter referred to as “Crotty et al II”].

The Applicant argues that the combined references of Porter et al, Bae et al and Crotty et al do not meet the limitations for the claims, because they combine to teach the treatment rather than evaluation (Applicant's Remarks of 14 October 2008 at page 7, para. 2). And further, that Bouyer et al does not disclose applying a treatment product to the skin after removing the first transparent substrate from the skin or applying and removing a second transparent substrate to undertake a comparison of the first with the second (Applicant's Remarks of 14 October 2008 at page 7, para. 4 through page 8, paras. 1-2).

The teachings of Fellows et al, *supra*, are incorporated herein by reference. Additionally, the teachings of Porter et al, Bae et al , Bouyer et al and Crotty et al II from this Office's Action of 13 May 2008 are incorporated herein by reference in their entirety.

It is important to note that within the context of a 35 USC §103(a) obviousness rejection, it is not required that each and every limitation in a claim be set forth in any one particular reference. Rather, it is imperative that a combination of references teach or suggest the limitations of a claim set. Such is the case here. While Applicant has noted that Porter et al, Bae et al and Crotty et al teach a treatment rather than an evaluation, it is important to note, as previously stated that the combined reference of Bouyer et al teach a means of making possible the accurate, self-diagnosis of common skin types (Page 1, lines 1-8). The premise for the disclosure is “an adhesive strip applied to the skin and then lifted off carries away surface elements of the epidermis which remain attached to the strip, *providing a sampling* which is a faithful impression of the skin surface” (Page 1, lines 10-14). The art also teaches that “the impression of wrinkles ... is easily seen” (Page 1, lines 23-24).

Importantly, Bouyer et al disclose a device that uses several adhesive parts “making possible several samplings” (Page 2, lines 1-3), and thus, comparators. It logically follows that in utilizing multiple test strips, there is a comparative analysis of more than one adhesive, as is disclosed by the present invention.

One of ordinary skill in the art would be motivated to combine these teachings because of the overlapping subject matter, which is the treatment of wrinkles and the evaluation of the efficacy of devices and methods for the same.

In light of the foregoing, for reasons stated, *infra*, it would have been *prima facie* obvious to one of ordinary skill in the art to create a cosmetic or care product system comprising a skin care product and a test device to determine its efficacy with a transparent polymeric film adhesive sensitive to the skin in order to determine the efficacy of the product to treat wrinkles and other signs of aging and that the product and test device could be packaged together.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Hughes whose telephone number is 571-272-6026. The examiner can normally be reached from 9:00 A.M. until 5:00 P.M. on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax number for the organization where this application is proceeding is assigned 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia R. Hughes/

Examiner, AU 161

/Raymond J Henley III/

Primary Examiner, AU 1614